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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/910,115	08/13/97	BAYCHAR	BAY-310

IM62/0831

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EXAMINER	
JUSKA,C	
ART UNIT	**PAPER NUMBER**
1771	9

DATE MAILED: 08/31/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)
08/910,115	Baychar
Examiner	**Group Art Unit**
Cheryl Juska	1771

☒ Responsive to communication(s) filed on *Feb 24, 1999* .

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire *3* month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) *1-24* is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) *1-24* is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐approved ☐disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____ .

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____ .

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). *3.5*

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Response to Amendment

1. As was previously indicated to Applicant's Attorney, Shrinath Malur, in the telephone interview of August 10, 1999, a new first action on the merits is as follows. Said new first action is set forth in view of Preliminary Amendments A and B, submitted on February 24, 1999, as Paper Nos. 6 and 7.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Specification

3. The disclosure is objected to because of the following informalities:

a. The first page of the specification should be amended to recited the relationship and status of the parent cases.

b. There are many terms on pages 4-13 that appear to be trademarks. These have not be properly identified.

Appropriate correction is required.

Double Patenting

4. Claim 17 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 14. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Objections

5. Claims 5, 6, 11, 12, and 20 are objected to because of the following informalities: In claims 5, 6, 11, 12, and 20 "by" should be replaced with "with." Appropriate correction is required.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 1-19 and 21-24 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 specifies an apparel worn by an individual. Individual cannot be claimed. It is recommended that Applicant insert "to be" before "worn".

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 is drawn to an embodiment of the invention comprising only two layers. Said embodiment is not disclosed in or enabled by the specification as originally filed.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

12. In claims 1, 8, and 20, the first layer is selected from a group, however, no group is set forth. Thus, the claim is incomplete and therefore indefinite. Also, the description of the fourth layer incurs the same problem.

For the purpose of determining the scope of Applicant's invention and therefore interpreting the claimed invention, the specification must be relied on for a definition of inner moisture transfer materials and outer moisture transfer materials since those terms are not definite if not read in light of the definitions found in the specification. Therefore, Applicant's claims are limited to those inner moisture transfer materials set forth on pages 4-5 and those outer moisture transfer materials defined on pages 8-10.

Claim Rejections - 35 USC § 102/103

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless --
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 8, 10, and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US Patent 5,021,280 issued to Farnworth et al.

Claim 8 is drawn to a three layer laminate comprising an inner moisture transfer material, a foam material, and an outer moisture transfer material. Claim 10 limits at least two layers to be attached by mechanical bonding. Claim 12 limits the outer layer to be coated with a waterproof film.

Farnworth discloses an insulating and moisture-transmitting composite fabric comprising a foam material sandwiched between two wicking fabric layers (abstract and Figure 1). The three layers are stitched together (col.2, lines 56-58). An optional fourth layer of a water impermeable material may be provided on the outer wicking fabric layer (col. 2, lines 63-66). The wicking fabric layers are taught to be a woven or knitted fabric (col. 2, lines 1-4).

However, Farnworth does not explicitly teach suitable fabrics for said wicking layers. In the absence of an explicitly teaching, it is presumed that any known fabric in the art which functions to transport moisture is suitable. Hence, it is reasonable to presume that the wicking fabric taught by Farnworth is inherently within the limitations claimed by the Applicant. The burden is upon the Applicant to prove otherwise. *In re Fitzgerald*, 205 USPQ 594. In the alternative, the presently claimed inner and outer moisture transfer materials would obviously have been provided as a result of the teaching of Farnworth of a wicking fabric. Note *In re Best*, 195 USPQ 433, footnote 4 (CCPA 1977). Therefore, said claims are rejected.

16. Claims 9 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Farnworth patent.

The limitations of claims 9 and 13 are not explicitly taught by said patent. However, it would have been obvious to one skilled in the art to laminate the inventive layers of Farnworth rather than to stitch them together. Motivation to do so would be the increased bond strength of a laminate and to prevent said stitching from unraveling. Additionally, it would have been obvious to one skilled in the art to choose an outer layer which is structurally made to repel water. Motivation to do so would be to obtain a waterproof outer layer without the need for an additionally layer on said outer layer. Thus, said claims are rejected as being obvious over the cited patents.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,682,613 to Dinatale
US 5,253,434 to Curley, Jr. et al.
US 5,216,825 to Brum
US 5,010,596 to Brown et al.
US 4,910,886 to Sullivan et al.
US 4,674,204 to Sullivan et al.
US 4,454,191 to von Blücher et al.
US 4,216,177 to Otto
US 4,529,641 to Holtrop et al.
US 3,779,855 to Fonzi et al.
US 3,607,593 to Semenzato

None of the cited prior art teaches the limited liner materials of the instant invention in combination with a foam and barrier membrane in the arrangement as claimed instantly.

18. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is (703) 305-4472. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mr. Terrel Morris, can be reached at (703) 308-2414.

The Office has established a Fax Center to handle Official communications from Applicants via facsimile. Two numbers have been provided: (703) 305-3599 for After Final communications and (703) 305-5408 for all other Official communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

TERREL MORRIS
PRIMARY EXAMINER
GROUP ~~1800~~ 1700

cj

August 18, 1999